

The Examiner states that claim 29 depends from claim 28, which has been canceled, and that it is unclear what the proper dependency of claim 29 should be. Applicants respond to this objection and rejection as follows.

Applicants have amended claim 29 to depend on claim 21. The specification and figures provide support for changing the repetition rate and spot size between the first and second laser outputs at these wavelengths. Applicants request, therefore, that this objection and rejection be withdrawn.

Claims 7, 8, 14, 15, 19, and 29 stand rejected under 35 USC 112, first paragraph for "containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention." The Examiner states that

"Claim 1 requires the use of first and second distinct repetition rates to produce first and second distinct output powers. Dependent claims 7, 8, 14, 15, 20, and 29 further require, in addition to the different repetition rates, a variety of other ways of achieving first and second output powers, such as the use of different spot sizes. Although the specification describes each of these features independently, it does not disclose using them together in such a manner as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification presents different repetition rates and different spot sizes, for example, as *alternatives* to one another, rather than complimentary methods which could be used together as claimed. See page 18 of the instant application."

Applicants respectfully traverse this rejection.

Applicants direct the Examiner's attention to the third embodiment described on pages 16 and 17 of the specification. The third embodiment describes decreasing output intensity and increasing spot size between the first and second laser outputs. Previously on the same page, applicants state that "Fig. 5 represents one method for changing the intensity of Nd:YAG laser output by changing the repetition rate of laser system 10." Applicants contend that one skilled in the art would be able to



infer from the embodiments and tables the concept of changing both the repetition rate and spot size to alter the power density.

Applicants further direct the Examiner's attention to Figs. 18-22 (examples 7-11). The table in Fig. 18 shows decreasing the repetition rate, decreasing the power, and holding the spot size constant (no change in focus or eff. spot) between the first and second laser outputs. The table in Fig. 19 shows increasing the repetition rate, increasing the spot size (changing the focus), and changing the output power between the first and second laser outputs. The tables in Figs. 20-22 show decreasing the repetition rate, increasing the power, and changing the spot size between the first and second laser outputs.

Claims 7 and 14 are directly supported by Fig. 19 with respect to changing the repetition rate and spot size between the first and second laser outputs. With respect to claim 8, and in addition to the support referenced above, Fig. 16 provides an example of changing the repetition rate and spot size between the first and second laser outputs while keeping the output power constant. Claim 15 is similar in many respects to claim 14; however, claim 15 recites alternative methods for changing the spot size as described in the specification on page 17, lines 1-4. Applicants believe that one skilled in the art would consider these implementations generic to the examples. With respect to claim 20, Fig. 19 supports changing the repetition rate and output power between the first and second laser outputs, and the laser system components recited in claim 20 are generic alternatives to each other for changing the output power. Claim 29, as amended, has already been addressed.

Applicants believe, therefore, that dependent claims 7, 8, 14, 15, 20, and 29 are supported by the specification and request that this rejection be withdrawn.

Claim 31 stands rejected under the judicially-created doctrine of double patenting over claim 1 of U.S. Patent No. 5,593,606. The Examiner states that "applicant's arguments with respect to claim 31 are

convincing, but a terminal disclaimer is required." Applicants respond to this rejection as follows.

Applicants enclose a terminal disclaimer to overcome the judicially-created, obviousness-type, double-patenting rejection of claim 31 over claim 1 of the '606 patent. Applicants request, therefore, that this rejection be withdrawn. Claim 31 is amended to include the inadvertently omitted word "power" to make the language of the fourth paragraph parallel to the language of the second paragraph.

Claim 32 stands objected to for being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants response to this objection as follows.

Claim 32 depends on claim 31, which is allowable in view of the technical disclaimer. Claim 32 is, therefore, now believed to be allowable, so applicants request the objection be withdrawn.

Claims 33 and 34 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent 5,593,606 to Owen et al. (Owen '606) in view of U.S. Patent 4,644,130 to Bachmann, Japanese patent publication 63-112088 to Takahashi et al., and Japanese patent publication 3-66488 to Sakuma. Applicants respond to this rejection as follows.

Applicants respectfully disagree with the Examiner's assessment as to the relevance of Bachmann, as discussed in the prior amendment, and have not translated the two newly cited Japanese references, Takahashi et al. and Sakuma, into English. Applicants have, however, withdrawn claims 33 and 34 from this application, but reserve the right to pursue them in a divisional application.

Claims 35 and 36 have been added. Applicants believe that the specification and figures provide ample support for performing the steps of claims 2 and 14 at the same wavelengths, respectively.

Applicants believe that their application is in condition for allowance and respectfully request the same.

Respectfully submitted,

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